

REMARKS

The Office Action dated January 9, 2009, has been received and carefully noted. The above amendments to the claims, and the following remarks, are submitted as a full and complete response thereto.

Claims 1, 3, 5-9, 18-23, 25-26, 28-33, and 36-47 are currently pending in the application, of which claims 1, 9, 18, 21, 25, 28, 30, 32, 36, 39-40, 43, and 45 are independent claims. It should be noted that claim 19 was omitted from the list of pending claims on the Office Action summary sheet. A rejection of claim 19 was presented, so it believed that this indication was simply an inadvertent error. Appropriate correction is respectfully requested. Claims 1, 3, 5-9, 18-23, 25-26, 28-33, and 36-47 are respectfully submitted for consideration.

The Office Action rejected claims 1, 3, 5-9, 18-23, 25-26, 28-33, and 36-47 under 35 U.S.C. §103(a) as being allegedly unpatentable as obvious over Applicants' allegedly Admitted Prior Art ("APA") in view of Chantrain *et al.* (U.S. Publication No. 2002/0194323) ("Chantrain"). The Office Action acknowledged that APA does not disclose all of the features recited in the claims and asserted that such feature are obvious in view of the disclosure of Chantrain. Applicants respectfully traverse this rejection.

Claim 1, upon which claims 2, and 5-8 depend, is directed to a method including passing a message from a first party to a second party in a communication system. The method also includes passing a response to the message from the second party to the first party, the response including at least one parameter in breach of a policy for a

communication between the first party and the second party. The method further includes detecting in a network controller that the response includes at least one parameter breaching the policy. The method additionally includes modifying, by the network controller, the at least one parameter to be consistent with the policy.

Claim 9 is directed to a controller configured to operate in a communication system. The controller is also configured to handle responses and requests between parties of communication sessions. The controller is further configured to forward a message from a first party to a second party. The controller is additionally configured to check whether a response to the message from the second party to the first party includes at least one parameter in breach of a policy for the communication between the parties. The controller is also configured to modify the at least one parameter to be consistent with the policy.

Claim 18, upon which claims 19-20 depend, is directed to a method including passing a message from a first party to a second party in a communication system. The method also includes receiving a response to the message from the second party, the response including at least one parameter in breach of a policy for a communication between the first party and the second party. The method further includes passing the response unmodified from the second party to the first party. The method additionally includes determining in a network controller that one or more of said at least one parameter breaches the policy.

Claim 21, upon which claims 22-23 depend, is directed to a controller configured to forward a message from a first party to a second party in a communication system. The controller is also configured to pass a response to the message unmodified from the second party to the first party, the response including at least one parameter in breach of a policy for a communication between the first party and the second party. The controller is further configured to determine in a network controller that one or more of said at least one parameter breaches the policy.

Claim 25, upon which claims 26 depends, is directed to a method including passing a message from a first party to a second party in a communication system. The method also includes receiving a response from the second party to the first party, the response including at least one parameter in breach of a policy for communication between the parties. The method further includes determining in a network controller that one or more of said at least one parameter is in breach of the policy. The method additionally includes sending a further message including a definition of the policy to the first party.

Claim 28, upon which claim 29 depends, is directed to a controller for providing communication configured to handle responses and requests between parties of communication sessions. The controller is also configured to forward a message from a first party to a second party in the communication system. The controller is further configured to receive a response from the second party to the first party, the message including at least one parameter in breach of a policy for communication between the

parties. The controller is additionally configured to determine that one or more of said at least one parameter is in breach of the policy. The controller is also configured to send a further message including a definition of the policy to the first party.

Claim 30, upon which claim 31 depends, is directed to a method including passing a message from a first party to a second party in a communication system. The method also includes receiving a response including at least one parameter in breach of a policy for a communication between a first party and a second party. The method further includes passing the response unmodified from the second party to the first party. The method additionally includes receiving from the first party a further message including one or more of the at least one parameter in breach of the policy. The method also includes detecting in a network controller that the further message includes the one or more of the at least one parameter breaching the policy.

Claim 32, upon which claim 33 depends, is directed to a controller for providing communication configured to forward a message from a first party to a second party in a communication system. The controller is also configured to forward a response including at least one parameter in breach of a policy for communication between the first party and the second party unmodified from the second party to the first party. The controller is further configured to receive a further message from the first party including at least one parameter in breach of the policy. The controller is additionally configured to detect that the further message includes at least one parameter in breach of the policy.

Claim 36, upon which claims 37-38 depend, is directed to an apparatus including a transmitter configured to send a message at a first party to a second party. The apparatus also includes a receiver configured to receive at the first party from the second party a response to the message, the response including at least one parameter in breach of a policy. The apparatus further includes a processor configured to modify, at the first party, at least one parameter into consistency with the policy. The transmitter is further configured to send a further message to a network controller, the further message including the modification.

Claim 39 is directed to an apparatus including first sending means for sending, at a first party, a message to a second user equipment. The apparatus also includes receiving means for receiving, at a first party, a response to the message from the second party, the response including at least one parameter in breach of a policy. The apparatus further includes controller means for modifying, at the first party, at least one parameter into consistency with the policy. The apparatus additionally includes second sending means for sending a further message to a network controller, the further message including at least one modified parameter. The controller means is further configured to further modify the at least one parameter in response to a response to the further message.

Claim 40, upon which claims 41-42 depend, is directed to a method including sending a message at a first user equipment to a second user equipment. The method also includes receiving a response to the message at the first user equipment from the second user equipment, the response including at least one parameter in breach of a policy. The

method further includes modifying at least one parameter into consistency with the policy. The method additionally includes sending a further message to a network controller, the further message including the modification.

Claim 43, upon which claim 44 depends, is directed to a method including forwarding a session initiation protocol message from a first user equipment to a second user equipment. The method also includes forwarding a session initiation protocol response containing a session description protocol offer from a second party to a first party. The method further includes receiving a succeeding request and checking whether the request contains a session description protocol answer for the offer that breaches a local policy. The method additionally includes, if the session description protocol answer breaches the local policy, returning a response that the answer is not acceptable, the response containing a local policy allowed session description protocol payload.

Claim 45, upon which claims 46-47 depend, is directed to a network controller configured to forward a session initiation protocol request from a first user equipment to a second user equipment. The network controller is also configured to forward a session initiation protocol response containing a session description protocol offer from said second party to said first party. The network controller is further configured to receive a succeeding request and checking whether the request contains a session description protocol answer for the offer that breaches a local policy. The network controller is additionally configured to, if the session description protocol answer breaches the local

policy, return a response that the answer is not acceptable, the response containing a local policy allowed session description protocol payload.

Applicants respectfully submit that APA and Chantrain (whether considered individually or in combination) fail to disclose or suggest all of the elements of any of the presently pending claims.

The Office Action cited paragraphs [0002]-[0010] (referring, one assumes, to the publication of the present application) as APA. It should be noted that the Office Action has not established that this cited material is prior art, and the present application does not state that this material is prior art. Accordingly, it is respectfully submitted that, as a technical matter, the Office Action has not substantiated a *prima facie* rejection, because it has not been established that the subject matter of paragraphs [0002]-[0010] of the present application is prior art.

Furthermore, it should be noted that even if the subject matter of paragraphs [0002]-[0010] were admitted to be prior art in some sense, it would not follow that it would be *citable* prior art, since the inventor's own prior work may be – in some sense – prior art to a particular invention, but may not be citable as prior art to show obviousness in view of 35 U.S.C. 103(c). Thus, it is respectfully submitted that for this additional technical reason, the rejection cannot properly be maintained.

Additionally, even if APA is prior art and citable, it would not follow that it would be obvious to modify APA with Chantrain. The Office Action's rationale for modifying APA with Chantrain is "for the purpose of managing the configuration of network

elements as taught by Chantrain” (Office Action, as presented at each of pages 3, 4, 5, 7, 8, 9, and 10 twice). This is the only rationale for making the numerous specific modifications allegedly necessary to make APA correspond to the claimed invention. However, this very broad and vague motivation does not compel the inclusion of any of the particular features asserted, as the particular features asserted will not themselves manage the configuration of network elements. Furthermore, it is not even alleged that one of ordinary skill in the art, beginning with the system and method alleged to be disclosed in APA would find such a system in need of further management of configuration, such that the addition of elements from Chantrain would be seen as desirable. Instead, it appears that the addition of certain selected features from Chantrain is simply the improper exercise of hindsight reconstruction in view of the disclosure of the present application. Although every rejection is necessarily to some degree in hindsight, the rejection must be justified based only on the knowledge available to one of ordinary skill in the art at the time the invention was made, and should not (as here) rely on the disclosure provided in the application under examination.

Moreover, even if the APA were prior art that was citable, and if even if it would be obvious to combine APA and Chantrain in general, the result would not correspond to what is claimed, because the combination of APA and Chantrain does not disclose all of the features of the rejected claims. Thus, the combination would not disclose all of the claim features, and/or one of ordinary skill would not have a reasonable expectation of

success in combining the features of Chantrain with APA to arrive at the claimed invention.

APA mentioned the offer/answer model, which enables two entities to make use of Session Description Protocol to arrive at a common view of a multimedia session by one participant offering another participant a description of the desired session from their perspective, and the other participant answering with a description of the desired session from their perspective, for example by reducing the offer.

Thus, for the sake of the argument, one might assume that APA discloses “passing a message from a first party to a second party in a communication system; passing a response to the message from the second party to the first party,” as recited by claim 1. However, even assuming *arguendo* that such is the case, Chantrain does not disclose (or otherwise render obvious) the other subject matter in claim 1. Moreover, a person of ordinary skill would not be motivated to consider applying, with a reasonable expectation of success, the teachings of Chantrain to the IMS system described in the APA, as will be discussed at greater length below.

Chantrain discusses in paragraphs [0018] and [0019] configuring of a network element through an intermediary of a network element proxy, which allows a configuration change upon service selection in compliance with network and/or service provider’s policies. Paragraphs [0037] to [0046] of the same reference discuss, with reference to Figure 1, a service deployment engine (SDE) 6 that retrieves a deployment template from a database 7. The SDE 6 consults a service deployment policy database 8

to obtain service deployment policies of the operator or service provider. As more than one deployment template can be used for deployment of the service, the retrieved operator service deployment policy is decisive for selection of the service deployment template by the SDE 6. The network element 4 is then configured in accordance with the selected service deployment template.

The rejection of claim 1 cannot be maintained for at least the following reasons (in addition, of course, to the reasons set forth above):

a) The office action has not specifically identified which features of Chantrain are considered to correspond to features of claim 1. It would seem that the SDE 6 and the service deployment template database 7 are considered to correspond to the first party and the second party in claim 1 according to Applicants' best guess (Applicants have guessed in an effort to expedite prosecution. However, USPTO policy suggests that rejections should specifically identify the mapping between the claims and cited art so that Applicants will not be required to guess).

The Office Action alleged that a policy for communication is disclosed in Chantrain. It might be that the number of templates in Chantrain is considered to correspond to the "parameter" in claim 1. In this case, the policy might be considered to be that a particular template is to be used. However, a policy as to which template is to be used is not a policy for communication between a first party and a second party as in claim 1, because the templates are for **network** configuration. Therefore, Chantrain does

not disclose, contrary to the assertion in the Office Action, “a policy for communication between the first party and the second party,” as recited by claim 1.

b) As noted above, APA relates to SIP offers and answers between user equipments. In contrast, Chantrain relates to network element configuration. These fields of technology are remote. Although the Office Action asserted that Chantrain is “In analogous art,” (at numerous pages in the Office Action, beginning at page 3) no evidence or explanation was provided for this conclusory assertion. There is no reason why a person of ordinary skill in the art knowing of APA would also know of the teachings of Chantrain. Thus, a person of ordinary skill in the art of APA would not look to Chantrain for improvements. Indeed, even if a person of ordinary skill in the art were to know of both documents, in view of the remoteness of the fields such a person would not be motivated to try to combine disclosed features. Any attempt to combine features of the APA and Chantrain is forced, artificial, and only possible with the benefit of hindsight.

c) Even if Chantrain and the APA did disclose in combination all the subject matter of claim 1 (which they do not), a person of ordinary skill in the art would not be motivated to combine them to such effect for the following reasons:

(i) A difference between Chantrain and APA is that in the paragraphs of Chantrain referred to (by the Office Action) messaging takes place between elements in a network, while, contrastingly, in APA an offer and answer are sent between participants, which the person of ordinary skill in the art would understand to be user equipments or

the like in view of page 2, line 4, of the present application. The person of ordinary skill in the art would not therefore be motivated to attempt to combine the teachings of these documents.

(ii) Another difference between Chantrain and APA is that APA discusses a participant answering another participant, while (in contrast) Chantrain discusses retrieving service deployment templates from the database 7 (see page 4, line 31, of Chantrain). The SDE 6 does not perform “passing,” as recited by claim 1 - plainly passing any templates to a user equipment or the like would be pointless because the SDE uses the retrieved templates to configure network elements (page 5, lines 11 and 12, of Chantrain). Since, rather than pass a response to a participant, the SDE performs other actions and passing the templates on would not be a helpful action (*i.e.* it would appear to be pointless to one of ordinary skill in the art), it cannot be seen from where the person of ordinary skill in the art would find motivation to combine the cited documents.

(ii) Yet another difference between Chantrain and APA is that Chantrain might be considered to disclose a policy that a template for configuration of network elements may be used, while the APA policy is concerned with definitions of allowed media parameters for a session in a network of a IP Multimedia Subsystem operator. It cannot be seen from where a person of ordinary skill in the art would find motivation to combine features relating to a policy regarding which network element configuration template to applying the APA policy.

In summary, APA and Chantrain cannot be combined to arrive at the method of claim 1. Thus, the method of claim 1 should be deemed non-obvious with respect to APA and Chantrain, because the combined references do not disclose all of the features, because the references would not be combined, or because the references would not – with reasonable expectation of success – be combined to result in an embodiment that corresponds to what is claimed.

Although each of the other independent claims has its own scope, each of the other independent claims should be considered non-obvious for at least some similar reasons. Other comments regarding the other independent claims are as set out in the following, which should not be viewed as exhaustive discussion of the numerous distinctions between the cited art and the claimed subject matter.

Claim 28 is, for example, also non-obvious at least because Chantrain does not disclose, as the Office Action had alleged, a controller configured to “determine that one or more of said at least one parameter is in breach of the policy; and send a further message including a definition of the policy to the first party.” It would seem that the Office Action may have been considering the SDE in Chantrain to correspond to the controller in claim 28. However, the SDE does not send a definition of the policy — in contrast, the SDE configures network elements using a template.

As to claim 30, Chantrain does not disclose “receiving from the first party a further message including one of more of the at least one parameter in breach of the policy; and detecting in a network controller that the further message includes the one or

more of the at least one parameter breaching the policy.” No such “further message” can be found in Chantrain. Similar comments are also applicable to claim 32, which has its own unique scope.

As to claim 43, neither the APA nor Chantrain discloses at least “receiving a succeeding request and checking whether the request contains a session description protocol answer for the offer that breaches a local policy; and if the session description protocol answer breaches the local policy, returning a response that the answer is not acceptable, the response containing a local policy allowed session description protocol payload.” Similar comments apply to claim 45, which has its own unique scope.

For the reasons (or similar) set forth above, it is respectfully submitted that each of independent claims 1, 9, 18, 21, 25, 28, 30, 32, 36, 39-40, 43, and 45 recites subject matter that is neither disclosed nor suggested in the attempted combination of APA and Chantrain. Claims 3, 5-8, 19-23, 25-26, 28-33, and 36-47 depend respectively from, and further limit claims 1, 18, 21, 25, 28, 30, 32, 36, 40, 43, and 45. Thus, all of claims 1, 3, 5-9, 18-23, 25-26, 28-33, and 36-47 recite subject matter is neither disclosed nor suggested in the combination of APA and Chantrain, and it is respectfully requested that the rejections of claims 1, 3, 5-9, 18-23, 25-26, 28-33, and 36-47 be withdrawn.

Applicants recognize that part of this response has been based on conjecture regarding what the intended rejection was. It is respectfully requested that, if the Examiner does not consider this response to adequately address the distinctions between the claims and the cited, that the Examiner provide a clear mapping between the cited art

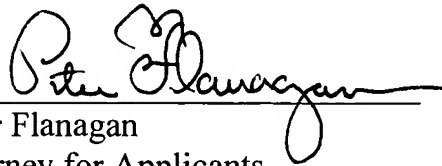
and the claims to that the Applicants can determine which features of Chantrain the Office Action has considered to correspond to which features of the claims. In the absence of such a mapping, Applicants respectfully submit that the rejection is not a *prima facie* rejection because the rejection does not adequately place Applicants on notice as to how the alleged prior art is being applied to the claims.

For the reasons set forth above, it is respectfully submitted that each of claims 1, 3, 5-9, 18-23, 25-26, 28-33, and 36-47 recites subject matter that is neither disclosed nor suggested in the cited art, that the combination of cited art is improper, and that APA has not been shown to be prior art. It is, therefore, respectfully requested that all of claims 1, 3, 5-9, 18-23, 25-26, 28-33, and 36-47 be allowed, and that this application be passed to issuance.

If for any reason the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by telephone, Applicants' undersigned representative at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper is not being timely filed, Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Peter Flanagan", written over a horizontal line.

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